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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/703,884 | 11/01/2000 | Robert S. Phillips | 48452-047 | 2817 |

7590 06/16/2005
Proskauer Rose LLP
Patent Department
1585 Broadway
New York, NY 10036

EXAMINER

JEAN, FRANTZ B

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| ART UNIT | PAPER NUMBER |
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2151

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/703,884

Applicant(s)

PHILLIPS ET AL.

Examiner

Frantz B. Jean

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-134 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-134 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/24/05, 10/18/04</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
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This office action is in response to applicant's correspondence filed 3/24/05. Claims 1-134 are presented for examination.

The allowance of claims 1-134 has been withdrawn. New art have been found.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-134 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent claims, for example, claim 1 describes "a user group of one or more users" which consists of a single user. However, the claims further down recite that the group must consists of more than one user.

In addition, the claims recite "the files of the file group". There is lack of antecedent basis for this limitation in the claims.

Correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-134 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-161 of copending Application No. 09704,262. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of application "262" anticipate the claims of the present application. The claims of "262" are narrower in scope than the claims of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1, 2-5, 7-21, 28, 31-42, 49, 51-56, 59-79, 89-100, 109-114, and 117-131 are rejected under 35 U.S.C. 102(e) as being anticipated by *Brown et al. Hereinafter "Brown" US patent Number 6,067,551.

As per claim 1, Brown teaches a computer implemented method for simultaneously multi-user editing of a document that includes a method providing multi-user file storage that comprises the steps of:

Enabling each user of a pre-subscribed user group of one or more users to operate an arbitrary client node at an arbitrary geographic location to communicate with a remote file server node via area network (Internet),

Enabling each user of the pre-subscribed group to access the files of the file group via the respective client node in communication with the remote file server node via the wide area network, including permitting more than one user of the pre-subscribed user group to access the file group at the remote file server node simultaneously, and maintaining the integrity of the files at the remote file server node by controlling each access to each of the files at the remote file server node so that each access to each of the files at the remote file server is performed, if at all, on a respective portion of the respective file as most recently updated at the remote file server node (latest version of the master copy), thereby enabling all native operating system application programming interfaces to operate so that all multi-user applications accessing the files function as if the remote server, which stores the files, and the client nodes, at which such multi-user applications execute, were on the same local area network (see col. 9 line 55 to col. 11 line 51).

Regarding claims 2-5, 7-21, 28, 31-42, 49, 51-56, 59-79, 89-100, 109-114, and 117-131, Brown implicitly and inherently teaches all the limitations related to these claims. Therefore, they are all rejected under the same rationale as claim 1 above (see Brown col. 9 et seq).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Howard US patent number 5,600,834.

As per claim 6, Brown does not teach automatically download from the remote file server node to the hoarding client node information for updating copy of particular fileHoward teaches these features (see col. 1-3). It would have been obvious to one ordinary skill in the art at the time of the invention to have combined Howard's features to Brown in order to keep the clients updated in regard to the network files status.

Claims 22- 27, 29-30, 43-48, 50, 57-58, 80-88, 101-108,115-116, and 132-134 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Shimbo et al. US patent number 5,835,601.


As per claims 22- 27, 29-30, 43-48, 50, 57-58, 80-88, 101-108,115-116, and 132-134 Brown fails to teach encryption and authentication of file sharing. Shimbo teaches these features (see col 5, and 15-17). It would have been obvious to one of ordinary skill in the art to have combined Brown with Shimbo in order to provide and implement security in the system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz B. Jean whose telephone number is 571-272-3937. The examiner can normally be reached on 8:30-6:00 M-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571 272 3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frantz Jean


FRANTZ B. JEAN
PRIMARY EXAMINER